

REMARKS

Claims 1 through 35 and 37 through 40 are pending in this application. Claims 24 through 27, 35, and 37 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application. Claim 36 is cancelled without prejudice or disclaimer of its subject matter.

I. Election/Restriction

The Examiner stated that claims 1-23 and 28-31 are withdrawn from further consideration pursuant to 37CFR§1.142(b), as being drawn to nonelected inventions, there being no allowable generic or linking claim.

1. Traversal

The Examiner notes that the traversal is timely traversed, but stated that as set forth in Paper No. 6 is not a traversal of the propriety of the requirement per se, but only related to whether certain claims are designated as generic or not, so the Examiner states that the election will be treated without traversal since no reasoning traversing the propriety of the requirement were set forth by the Applicant.

The Applicant strongly objects to the statement that election was made without traversal.

The Applicant laid an array of reasons for why the restriction and election of species was improper. The Applicant directly made arguments concerning the restriction requirement.

The Examiner stated that the arguments only related to whether certain claims are designated

as generic or not to the propriety of the requirement.

However, the Applicant argued in point 4 in paper number 7 that the general test for restriction of species was not met. Clearly that pertains to the restriction and election of species. Further, in point 5 of paper number 7, the Applicant argued that the Examiner failed to meet requirements set forth by MPEP §803 (entitled “Restriction when proper”) where the Examiner must show that the inventions are independent or distinct and that there is a serious burden on the Examiner. The Applicant then goes on in page 7 of paper number 7 of how the Examiner has failed to show a burden like for example failing to show that different embodiments are in different classes. Paper number 7 continues to point out that in paper number 5, the Examiner did not allege in any way a serious burden. Further, the Applicant goes on to state why the Examiner should not have a serious burden by giving examples of how claims cover multiple species. Questioning the burden on the Examiner is clearly by itself a proper reason for traversal as highlighted by MPEP §803 on restrictions when proper.

Clearly as shown above, the Applicant in paper number 7 made a provisional election with traverse.

2. MPEP §803 Restriction when proper

As the Applicant mentioned in paper number 7, the Applicant states again that as specifically stated in MPEP § 803, the examiner must show that the (A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP §806.05 - §806.05(i)); **and** (B)

There must be a **serious burden** on the examiner if restriction is required (see MPEP §803.02, § 806.04(a) -§806.04(i),§808.01(a), and § 808.02).

The examiner must prove that the inventions are independent or distinct and that there is a serious burden on the examiner.

It is respectfully submitted that there would not be a serious burden upon the examiner in searching the invention species I through XVI.

First the Examiner has failed to show any kind of burden. The Examiner has failed to show that the different embodiments are in different classes for example. As stipulated in *MPEP* §803, if the search can be made without serious burden, the Examiner must examine it on the merits even if there are separate and distinct inventions. The Examiner has not alleged any serious burden in Paper No. 5 dated 18 October 2002 and thus the Examiner must examine the entire application.

Secondly, as seen above, for example, in species VI, claim 24 is also in species VIII. Further, claim 10 (species III) is dependent on claim 1 which has the features of species I and II for example. Claim 12 has the features of both species I and species II. Therefore, there would be no serious burden on the Examiner and as required by *MPEP* §803, the Examiner must examine the entire application on the merits.

The Examiner on page 2 of paper number 8 states that regarding the burden, “it is noted that each of the disclosed species require separate search exclusively for that species before patentability of the claims readable on that species can be considered. Moreover, the searches for the disclosed

species are not necessarily coincident.” The Examiner mentioned general statements but provided no proof of the burden such as giving examples of different classes for the different embodiments and an example of why the species are not coincident. It is the Examiner’s burden of proof to provide examples his serious burden under MPEP §803. These safeguards are set by the USPTO to ensure that an inventor is given due process without conclusory judgements.

3. Provisionally elected group

Further concerning the provisionally elected species, the Examiner gave a choice of group VI being figures 8 and 10 and group VIII being 8 and 11. However, figure 10 (backpack 710) is only a closed view of the backpack of figure 8 (backpack 710) which is also the backpack of figure 11 (backpack 710). As mentioned at the top of paragraph 60, “Looking at Fig. 11, the backpack 710 (and also on bag 810) can have also a strap 752 secured to the top of the bag 710 that allows for clothes hangers to hang for jerseys or street clothes.” It specifically refers to backpack 710 which is the backpack in figure 8 (backpack 710). Further, figure 10 is only the backpack 710 (figures 8, 11) in the closed position as mentioned specifically on page 17, paragraph 61, first sentence, “As seen in Fig. 10, the backpack 710 is in a closed position.” Therefore, the provisionally elected group should also include figure 11 as supported by the specification.

II. Drawings

The Examiner objected to the showing of the straps in claim 24. As mentioned in paragraph 63, “Referring to Fig. 15, the backpack 910 is the same as backpack 710 except that backpack 910

includes a pair of wheels..." Further, page 5, paragraph 30 states that Fig. 15 is a view of the backpack of Fig. 8 having wheels. The backpack in figure 15 shows straps 930. Therefore, from this disclosure in the specification and the disclosure in claim 24, figure 20 is added with an accompanying description after paragraph 34 in the brief description of the drawings. No new matter is added because of the above mentioned support in the disclosure.

Accordingly, a letter to the Office Draftsman accompanies this response. Indication in subsequent Office correspondence of the acceptance to the drawing corrections proposed in the letter, is requested to enable applicant to timely arrange for the corrections to be made prior to the date for payment of any issue fee. No new matter was added.

Even without the additional figure, the drawings do support the disclosure of the strap since it mentioned in the disclosure that figure 15 is the same backpack as in figure 8 except for the additional wheels. Further, straps are also shown in the backpacks in figures 3 and 7 along with the above mentioned figure 15.

Concerning the folding in claim 33, figure 10 shows a bag folded in one direction and figure 18 shows a bag folded in the reverse direction. Further, in the specification on page 5, paragraph 25 mentions that figure 10 is the backpack of figure 8 in the closed position. On page 5, paragraph 33, the bag is stated to be folded in reverse. Further, on page 10, at the end of paragraph 45, it states "the bag can be folded in reverse with the compartments on the outside allowing for ventilation." Furthermore, since claim 33 is an original claim, its disclosure also supports such a feature of the present invention.

III. Specification

The Examiner states that there is no antecedent basis for “top portion” and “bottom portion” in the specification. Top portions and bottom portions of certain sections of the bags are mentioned throughout the specification and referenced in the drawings.

For example in claim 32, a top portion is mentioned concerning the wall of the backpack. In paragraph 59, a top portion of the backpack of figures 8, 10, *etc.*, is mentioned and described for instance. The end of paragraph 57 also mention a bottom of the bag of figures 8, 10, *etc.* Therefore, there is an antecedent basis for the top and bottom portions.

One must look at what is the top portion referring to. For example in figure 8, the top portion of the back wall is 784 as mentioned clearly in paragraph 59.

IV. Claim rejections- 35USC§112 (2nd paragraph)

The Examiner concerning claim 24 questioned clarity of “external object.” Claim 24 was amended to clarify “external object.”

The Examiner stated that the claims should recite a plurality of walls and not just the back wall and that such would be omitting essential elements. However, looking at MPEP§2172.01, the elements must be essential to practice the *invention*. MPEP §2172 does not mean that all elements of an apparatus have to be mentioned but it means the elements of the *invention*. For example, if a claim for an invention concerning a flat screen of television does not include a power supply, one

cannot say that the power supply is essential for the invention. The power supply is needed to allow for the television to work, but it is not essential for the invention of the flat screen television.

Further, the description and the drawings show how the back wall forms an element of the invention. Further in paragraph 13, an objects mentions that “It is another object to have objects organized in a single plane.”

Therefore, no essential elements are missing from the claims according to MPEP §2172.

The Examiner further states that claim 24 is inconsistent. The Examiner argues that it does not seem that the fastening portion or the zipper does not attach two ends of the back wall together. The applicant disagrees. Respectfully, if two ends of the back wall do not attach together then how does figure 10 close the backpack? It is clear from the drawings and specification of the present invention that at some point one end of the wall attach to the other end to close the backpack.

The Examiner states that it is unclear what comprises the back wall. As seen in figure 8, the back wall is clearly referenced as 780.

In claim 25, the Examiner had a question about the antecedent basis of the “top portion.” Concerning “top portion” one must look to see that is the top portion referring to. In claim 25, it is the top portion of the back wall. Paragraph 59 clearly mentions the top portion of the back wall is 784 as mentioned clearly in paragraph 59. As seen in figure 8, the top portion of the back wall is above the middle portion 718 that are set to allow the folding of the bag, as mentioned in paragraph

57. To correct for antecedent basis, in claim 25, “the top portion of said back wall” was corrected to “a top portion of said back wall.”

In claim 25, concerning “opposite sides” (of said back wall) antecedent basis to earlier in the claim is not necessary since it is the first introduction of “opposite sides” and language does not give the impression that it was introduced earlier.

In claim 26, “said” was added in front of “opposite sides” in claim 26 to show the connection to the “opposite sides” of claim 25.

The Examiner suggested in claim 25 to change “a first and second side wall” to “a first and second side walls.” However, since “a” should not precede plural walls, therefore, the section of claim 25 was corrected to “a first side wall and a second side wall”.

In claim 25, the Examiner recommended the change of “a first and second side portion” to “a first and second side portions.” However, looking closely at claim 25, no such language is seen. Further, no such language is seen in any other claim. In order to help the Examiner and to expedite the present patent application, the Applicant looked further in the claims and attempted to correct any further antecedent basis or other grammatical problems that were not noted by the Examiner. For example in claim 26, the Applicant corrected “a first and second portion” to “a first extended portion and a second extended portion” as supported by the disclosure at the end of paragraph 61.

Concerning claim 27 and “a portion”, at the end of paragraph 39, it mentions that the middle portion can be relatively flat to accommodate an easier closing. In claim 24, it mentions the folding of the bag. Therefore to connect the folding of claim 24 with the fold of claim 27, claim 27 was amended.

The Examiner asks what is the “second unit”. Claim 32 clearly describes the second unit as “accommodating the hanging of hangers for clothes disposed on the top portion of the front side of said back wall.” Claim 32 is an original claim and therefore part of the disclosure of the present invention. The second unit can be for example seen in figure 11 which as mentioned at the top of paragraph 60 mentions “Looking at Fig. 11, the backpack 710 (and also on bag 810) can have also a strap 752 secured to the top of the bag 710 that allows for clothes hangers to hang for jerseys or street clothes.”

In Claim 35, the Examiner mentioned that “and connect a bottom of said right wall” is confusing. Concerning claim 35, the claim was amended for clarification purposes.

The Examiner stated that “first wall” was unclear. However, looking at claim 35 it can be seen that at the bottom portion connecting the side walls and it extends from the bottom portion. For example, reference 722 can extend from the bottom portion and connect the side walls. At the end of paragraph 57, wall 722 helps to hold the sides together. Reference 722 is only an example and does not limit the claim.

The Examiner has some question concerning the “first unit” in claim 38. For example, at the top of paragraph 62, it mentions clearly that backpack 710 which is shown in figure 8, 10, can also have a strap 752 that allows for clothes hangers to hang clothes. As supported by the specification, the figure 8 has been amended to reference the strap 752 for hanging clothes which shown in greater detail in figure 11. The unit for hanging clothes is also mentioned in the originally filed claim 32 which is part of the original disclosure. Therefore, it is clear that a unit for accommodating the hanging of clothes is part of the present invention. Figure 8 was amended to show this unit as properly supported by the specification (paragraph 62) and the originally filed claim 32, and therefore no new matter is added. Accordingly, a letter to the Office Draftsman accompanies this response. Indication in subsequent Office correspondence of the acceptance to the drawing corrections proposed in the letter, is requested to enable Applicant to timely arrange for the corrections to be made prior to the date for payment of any issue fee.

The Examiner asks that numeral identifications be given to all the claimed elements. However, this would unfairly limit the claims of the Applicant. As shown above, the Applicant has provided examples of the limitations in order to help the Examiner without limiting the scope of the invention. If there are further questions, the Applicant is most willing to give example reference numbers but not where it may limit the claimed present invention during the course of the prosecution.

V. CLAIM REJECTIONS - 35 U.S.C. § 102

Claim 35 was rejected under 35 U.S.C. § 102(b) as being anticipated by Fournier (U.S. Patent 6,193,034) or Tong (U.S. Patent 6,334,519) or DeChant (U.S. Patent 6,196,718).

No claim is anticipated under 35 U.S.C. § 102 (b) unless all of the elements are found in exactly the same situation and united in the same way in a single prior art reference. As mentioned in the **MPEP § 2131**, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Every element must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ2d 1913, 1920 (CAFC 1989). The identical invention must be shown in as complete detail as is contained in the patent claim. *Id.*, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970), and MPEP 2143.03. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

DeChant does not disclose the compartments being in a single plane as mentioned in the presently claimed invention. The bottom portion of Dechant is a compartment in another plane as seen in figure 12 being the front cover drawing.

Tong also does not disclose the compartments being in a single plane. For example, in figure 3, there are side compartments that are not quickly viewable for their content.

Fournier seems to have all the compartments in a single plane but as mentioned in the amended claim 35, it lacks the feature of being a backpack where it can be transported on the back of a user.

VI. REJECTION OF CLAIMS (35 U.S.C. § 103)

Claims 24 through 27, 33, and 36 through 38 were rejected under 35 U.S.C. §103(a) as being unpatentable.

According to MPEP 706.02(j), the following establishes a *prima facie* case of obviousness under 35 U.S.C. §103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The

teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The first point in MPEP 706.02(j) states that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.

The mere fact that the teachings of the prior art can be combined or modified does not itself make the resultant *prima facie* obvious. MPEP 2143.01.

Secondly, MPEP 706.02(j) states that there must be a reasonable expectation of success.

The third point in MPEP 706.02(j) states that the prior art reference (or references when combined) must teach or suggest all the claim limitations.

A. Claims 24-27, 33, and 36-38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fournier(U.S. Patent 6,193,034) in view of Scott(U.S. Patent 140,548) or Martz (U.S. Patent 6,286,461). Further, Claims 24-27, 33, and 36-40 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tong (U.S. Patent 6,334,519) or Dechant (6,196,718) in view of Scott(U.S. Patent 140,548) or Martz (U.S. Patent 6,286,461). The Applicant respectfully traverses.

The Examiner stated that Fournier, Tong, or Dechant can be modified by Scott to have the straps for use as a backpack. However, Scott as seen in the drawings is only for shoulder carrying. Further as mentioned in the second column toward the end of the paragraph of page 1 of the specification of Scott, it states that “I is a strap adapteded the trunk to be swing and carried by the *shoulder*; and J J (only one being shown) are shawl or blanket straps...” (emphasis added). Clearly, Scott does not teach or suggest the use of the modifying Fournier to be used as a backpack but more for shoulder carrying.

The Examiner stated that Fournier, Tong, or Dechant can be modified by Martz to teach the straps of the present invention. However, clearly as seen in figure 4 and the specification of Martz, Martz is for carrying of dogs or other animals. A person of ordinary skill in the art would not try to modify to attach a plurality of compartments in the inside to hold further objects in the inside of the bag. This would clearly harm the animal within the bag.

Concerning claim 25, the Examiner cites reference 4 of Fournier as teaching or suggesting the first and second sidewalls (4). However, Fournier does not teach or suggest the *first and second side walls extending from the bottom portion of said back wall* as mentioned in claim 25. As seen in Fournier, the side wall extends only from a middle portion of the back wall. Scott or Martz do not add anything further. Therefore, the combination of Fournier and Scott or Martz fails to teach or suggest the limitation of claim 25.

Concerning claim 26, the combination of references fails to teach or suggest a *bottom portion of said back wall including a first extended portion and a second extended portion extending on said opposite sides of said back wall, the first extended portion of said back wall connected and forming an angle with the first side wall, the second extended portion of said back wall connected and forming an angle with the second side wall, a width of the bottom portion of said back wall being greater than the width of a top portion of said back wall.* For example, Fournier, Tong, or Dechant in combination with Scott or Martz do not teach the first and second extended portions of back wall connected and forming an angle with the side walls as supported by for example by the end of paragraph 61 which mentions for example the extended portion 786 of the bottom back wall 782 of the backpack 710 forming angles with the side walls 724 in the present invention. Nothing in any of the references shows such an angle formation.

Concerning claim 32, the second unit accommodating the hanging of hangers is not taught or suggested by the combination of references. In point 9 of paper number 8 of the Examiner's arguments, the Examiner mentioned that the combination teaches a portion being the second unit, but the Examiner failed to provide a reference number correlating to the second unit.

Therefore, looking at Fournier, nothing can be seen that can accommodate the hanging of clothes. Fournier only shows a hanger loop 12 which is to allow the bag to be hung vertically from a hook or rod (col. 4, lines 63-65), but this does not accommodate the hanging of clothes. Tong, or Dechant or Scott or Martz also do not teach or suggest such a limitation.

Further, “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 175 F.3d 994, 50 USPQ.2d 1614 (Fed. Cir. 1999). The showing must be “clear and particular” without broad generalized conclusory statements. *Id.* There must be specific statements showing the scope of the suggestion, teaching, or motivation to combine the prior art references. *Id.* at 1000. There must be an explanation to what specific understanding or technical principle would have suggested the combination of references. *Id.* Respectfully, the motivation given by the examiner of “efficiency”, is a broad generalized conclusory statement.

As mentioned on page 6 of paper number 8, the Examiner states that Scot or Martz are combined with Fournier (point 9 of Examiner’s arguments) or Tong or DeChant (point 10 of Examiner’s arguments) because it would make the bag easy to carry. This, however, as warned by the court of *In re Dembiczak* would be a broad conclusory statement that would not support a motivation to combine or modify the references.

B. Claim 34 was rejected under 35 U.S.C. §103(a) as being unpatentable over Tong(U.S. Patent 6,334,519), Dechant (6,196,718), or Fournier(U.S. Patent 6,193,034) in view of King (U.S. Patent 2,205,205). The Applicant respectfully traverses.

The Examiner stated that Tong, Dechant, or Fournier can be modified by King to teach or

suggest an alternative means of securing the contents. However, the combination of Tong, Dechant, Fournier and King still do not teach or suggest a pair of straps accommodating a carrying of the bag on the back of a user. For Example in King, as seen in the figures, no straps for carrying of the bag is shown, not to mention a strap for carrying on the back. Only a *hand grip* is mentioned for reference 17. Further, King is not intended to be carried on a back or shoulder, since as the title states that it is a case for toilet accessories.

Concerning the motivation to modify the combination of references with King, the Examiner states that the straps of King provide alternative means for securing content. As mentioned above this reason also, as warned by the court of *In re Dembiczak* would be a broad conclusory statement that would not support a motivation to combine or modify the references.

VII. Conclusion

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. Should there be deficiency in payment, or should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of

Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "R. E. Bushnell", written over a horizontal line.

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